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MIRUS CORPORATION
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In re Application of LEWIS et al.
Application No. 10/007,448
Filed: November 7, 2001
Attorney Docket No. Mirus.030.03

:
: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
: and 1.78(a)(6)

This is a decision on the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6), filed 09 September 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 and 119(e) for the benefit of priority to the prior-filed nonprovisional and provisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

With regard to Item (2), the surcharge fee required by 37 CFR 1.17(t) has been submitted¹.
With respect to Item (3), the petition contains a proper statement of unintentional delay.

However, the petition does not comply with Item (1) above. U.S. application 09/391,260 cannot claim benefit under 35 U.S.C. 120 to U.S. application 09/975,573 as the latter was not filed prior to the 09/391,260 application. Thus, the reference to nonprovisional application 09/975,573 is

¹ The petition was not accompanied by the requisite fee. The requisite fee was submitted on 16 March 2006.

not a prior filed application and cannot be included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii).

Accordingly, the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications does not satisfy the conditions of 37 CFR 1.78(a), and thus, the petition is cannot be granted, at this time. Accordingly, before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) and a substitute amendment² which sets forth the relationship of the prior-filed application(s) is required.


Further correspondence with respect to this matter should be addressed as follows:

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² Note 37 CFR 1.121